



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,476	06/27/2003	Jason Cahill	MSFT-2153/302760.1	7872
41505 7590 10/15/2007 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER NALVEN, ANDREW L	
			ART UNIT 2134	PAPER NUMBER
			MAIL DATE 10/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,476

Applicant(s)

CAHILL ET AL.

Examiner

Andrew L. Nalven

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-24 are pending.

Response to Arguments

2. Applicant's arguments filed 8/22/2007 have been fully considered but they are not persuasive.

3. Applicant has argued against the rejections under 35 USC 101 regarding claims 7-24. The rejections under § 101 towards claims 13-24 have been removed.

Regarding claims 7-12, the cited claims are directed towards a medium with an email and attachment stored thereon. This is an example of a data structure per se that has no functionality. An email and attachment are data structures that are utilized by software programs in conjunction with hardware in order to provide functionality. An email and attachment by itself is inoperative. As a result, Examiner maintains the rejection of claims 7-12 under § 101.

4. Applicant has argued on page 13 that Olkin fails to teach the RM-protected email and RM-protected attachment sharing the generated content key and the generated bind ID. Specifically, Applicant argues that Olkin's list of computer seals, cited by Examiner as the bind ID, are not shared by both the email and attachment. Examiner respectfully disagrees. Olkin teaches a bind ID in the form of an sList. The sList is a list of computer seals. The sList contains seals relating to both the email and to the

Art Unit: 2134

attachment. Thus, Examiner maintains that Olkin's sList is shared by both the email and attachment because all seals are stored within the sList and the sList is associated with both the email and the attachment.

5. Applicant further argues that Olkin's sList cannot meet the limitation whereby the bind ID and the generated content key can be applied to render the protected email and attachment. Examiner respectfully disagrees. Initially, Examiner notes that the current presentation of the claims states that the content key and bind ID "can be applied to render." This language suggests, but does not require that the content key and bind ID are used to render the email and attachment. Examiner suggests an amendment to more positively recite that the content key and bind ID are used to render the content. In any case, Olkin anticipates rendering the email and attachment using the bind ID and content key (Olkin, column 16 lines 29-50) by disclosing a receiving email client that decrypts the email with the message key and utilizes the sList to ensure the email is authentic before allowing the user to read the email.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 7-12 are rejected under 35 U.S.C. 101** because the claims are directed towards nonstatutory subject matter. The cited claims are an example of functional

Art Unit: 2134

descriptive material consisting of data structures and programs that impart functionality when employed as executed by a computer component. The functionality of functional descriptive material is realized only when the functional descriptive material is claimed as being embodied on a computer readable medium and is claimed as executed by a computer component. The cited claims provide no tangible computer components that work in conjunction with the functional descriptive material to impart functionality and as a result the claims are not statutory because they fail the practical application requirement of § 101 by failing to provide a useful, concrete, and tangible result (see MPEP 2106).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 7, 13, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Olkin et al US Patent No. 6,584,564.

7. With regards to claims 1, 7, 13, and 19, Olkin teaches authoring the email with the RM protectable attachment (Olkin, column 5 lines 35-45, email is created, column

Art Unit: 2134

14 lines 36-50), generating a content key KD (Olkin, column 13 lines 53-57, message key is generated), generating a bind ID (Olkin, column 13 lines 53-60, seals are computed), firstly applying RM protection to the RM protectable attachment of the mail based on the generated KD and the generated bind ID (Olkin, column 14 lines 36-50, attachment encrypted with message key and has seals applied) attaching the RM protected attachment to the email (Olkin, column 14 lines 23-50) secondly applying RM protection to the email with the attached RM protected attachment based on the generated KD and the generated bind ID (Okin, column 14 lines 1-20, email encrypted with message key), wherein the RM protected email and the RM protected attachment thereof share the generated KD and the generated bind ID such that a license obtained for the RM protected email and having therein the generated bind ID and the generated KD can be applied to render the RM protected email and also the RM protected attachment thereof (Olkin, column 14 lines 36-50, both message and attachment encrypted using message key and both have seal).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2134

8. **Claims 2, 8, 14, and 20 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Olkin et al US Patent No. 6,584,564 in view of Kobata et al US PGPub 2002/0077985.

9. **With regards to claims 2, 8, 14, and 20**, Olkin teaches protecting KD to an RM server so that all requests for a license corresponding to the item are directed to such RM server (Olkin, column 16 lines 1-30, if authorized security server sends receiver the messageKey), generating rights data including the protected KD and generated bind ID and setting forth each entity that has rights with respect to the RM protected email and the RM protected attachment thereof and for each such entity a description of such rights (Olkin, column 16 lines 3-15, receivers table must match the receiverAddr, column 16 lines 32-42, generates new seals for validation), and encrypting the item with KD to form KD(item) (Olkin, column 14 lines 1-50), but fails to teach attaching the rights data to the corresponding KD(item) to form a package. However, Kobata teaches attaching the rights data to the corresponding KD(item) to form a package containing the item in an RM protected form (Kobata, paragraphs 0092, 0097, 0099, 0225) whereby the signed rights data from the package for any item may be employed to obtain the license for the RM protected email and the RM protected attachment thereof (Kobata, paragraphs 0092, 0097, 0099, 0225), such license thus including the bind ID of the signed rights data and being bound to the RM protected email and the RM protected attachment thereby (Kobata, paragraph 0100). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Kobata's method of packing content with rights because it offers the advantage of allowing

secure transfer of content with assurance that there will be lifelong control of the digital content (Kobata, paragraph 0010-0011).

10. **Claims 3-4, 6, 9-10, 12, 15-16, 18, 21-22, and 24 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Olkin et al US Patent No. 6,584,564 and Kobata et al US PGPub 2002/0077985, as applied to claim 2 above, and in further view of Hurtado et al US Patent No. 6,983,371.

11. **With regards to claims 3, 9, 15, and 21**, Olkin as modified fails to teach submitted the generated rights data for signing and receiving signed rights data based thereon. However, Hurtado teaches submitting the generated rights data for signing and receiving signed rights data based thereon whereby the signed rights data is tamper-resistant in that any changes to the signed rights data will cause the signature to fail to verify and wherein attaching the rights data comprises attaching the signed rights data (Hurtado, column 43 lines 5-30 and column 44 lines 42-46). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Hurtado's method of signing rights data because it offers the advantage of allowing the verification of the authenticity and integrity of a file (Hurtado, column 43 lines 40-45).

12. **With regards to claims 4, 10, 16, and 22**, Olkin teaches submitting the rights data for signing comprises submitting the rights data to the RM server for signing (Olkin, column 43 lines 5-10).

Art Unit: 2134

13. **With regards to claims 6, 12, 18, and 24**, Olkin as modified teaches a KD(item) as noted above, but fails to teach the concatenating the signed rights data with the corresponding KD(item) to form a package containing the item in an RM protected form. However, Hurtado teaches the concatenating the signed rights data with the corresponding KD(item) to form a package containing the item in an RM protected form (Hurtado, column 43 lines 5-30 and column 44 lines 42-46, single package). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Hurtado's method of signing rights data and concatenating rights with the encrypted data item because it offers the advantage of allowing the verification of the authenticity and integrity of the content package (Hurtado, column 43 lines 40-45).

14. **Claims 5, 11, 17, and 23 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Olkin et al US Patent No. 6,584,564 and Kobata et al US PGPub 2002/0077985, as applied to claim 2 above, and in further view of Xiao US Patent No. 6,571,337.

15. **With regards to claims 5, 11, 17, and 23**, Olkin as modified fails to teach encrypting KD with a public key of the RM server to result in RM(KD), whereby only the RM server with a corresponding private key can apply the same to reveal KD. However, Xiao teaches encrypting KD with a public key of the RM server to result in PU-RM(KD) (Xiao, column 4 lines 50-67), such that only the RM server with a corresponding private key can apply the same to reveal KD (Xiao, column 4 lines 50-67, only clearance center can decrypt). At the time the invention was made, it would have

been obvious to a person of ordinary skill in the art to utilize Xiao's method of encrypting content keys because it offers the advantage of preventing unauthorized access to the content key and the data itself (Xiao, column 4 lines 57-67).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Nalven whose telephone number is 571 272 3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

Art Unit: 2134

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Nalven




KAMBIZ ZAND
SUPERVISORY PATENT EXAMINER